REMARKS

Upon entry of this Amendment, claims 1-39 will remain pending and under current examination.

In the Office Action,[1] the Examiner rejected claims 1, 11, 17, 18, 28, 29 and 39 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 11, 17, 18, 28, 29, and 39 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,842,737 to Stiles et al. ("*Stiles*").

Applicant respectfully traverses the Examiner's rejections for the following reasons.

I.   Rejection of claims 1, 11, 17, 18, 28, 29, and 39 under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 112, second paragraph

Applicant respectfully traverses the rejection of claims 1, 11, 17, 18, 29 and 39 under 35 U.S.C. § 112. In rejecting each of these claims, the Examiner asserts: "The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action at p. 2. The Examiner asserts that the specification does not contain support for "initiating a procedure to retrieve from the metrics database," "determin[ing] a subset of unique tags from the set of tags based on a condition," and "combin[ing] like additive attributes," as recited by the claims (Office Action at p. 2).

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicant respectfully disagrees with the Examiner's rejection for at least the reasons set forth in the reply filed January 12, 2006. Nevertheless, in an effort to expedite prosecution, Applicant hereby amends claims 1, 3-7, 9-12, 18, and 29 to remove "initiating a procedure" and "determining ... based on a condition." Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claims 1, 11, 17, 18, 28, 28, and 39 under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 112, second paragraph.

Regarding the claimed "combin[ing] like additive attributes," the Examiner asserts: "The disclosure lacks ... a clear description on how to combine the like additive attributes and what are the 'like attributes'" (Office Action at p. 2). Cambridge online dictionary defines "like" as "similar to." *Available at:* http://dictionary.cambridge.org/. Therefore, "combining like additive attributes," as recited by claim 17, means combining similar additive attributes. Applicant directs the Examiner to Applicant's specification at, for example, Fig. 2 and at paragraphs 016, 017, 026, 028, 032, and 034, for description of like attributes and how to combine like additive attributes. Similar or "like attributes" include, for example, pass metrics, fail metrics, and time metrics (paragraphs 016 and 028). These attributes may be "combined" by, for example, adding together time metrics for each line of code to determine the total execution time for a module of a software program (FIG. 5 and paragraphs 016, 017, and 026).

In view of the foregoing, Applicant submits that the "combining like additive attributes" is clear and would be readily understood by one of ordinary skill in the art. Accordingly, Applicant respectfully requests that the rejections of claims 1, 11, 17, 18, 28, 29, and 39 under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 112,

second paragraph, be withdrawn. Applicant provides this exemplary description of "like

attributes" to aid the Examiner; however, the above description of "like attributes" is not

restrictive of the invention, as claimed.

II. Rejection of claims 1-39 under 35 U.S.C. § 102(e) as being anticipated by *Stiles*

Applicant respectfully traverses the rejection of claims 1-39 under 35 U.S.C.

§ 102(e) as anticipated by *Stiles*. In order to properly establish that *Stiles* anticipates

Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of

the claims in issue must be found, either expressly described or under principles of

inherency, in that single reference. Furthermore, "[t]he identical invention must be

shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131,

quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913,

1920 (Fed. Cir. 1989).

Stiles does not disclose each and every element of Applicant's claimed invention.

Claim 1 recites a combination including, for example:

> providing a <u>metrics database</u> comprising metrics data that describes <u>characteristics of a software product</u>;
> ...
> retrieving from the metrics database a <u>set of tags</u>; and
> determining a <u>subset of unique tags</u> from the set of tags based on a set of parameters included in the query.

Emphasis added.

Stiles fails to teach or suggest at least "providing a metrics database comprising

metrics data that describes <u>characteristics of a software product</u>," as recited by claim 1.

The Examiner asserts that *Stiles'* archive center 334 meets the claimed "metrics

database" (Office Action at p. 3). Even assuming that *Stiles'* archive center 334 stores

metric data, *Stiles* does <u>not</u> teach or suggest storing in archive center 334 metric data "that describes <u>characteristics of a software product</u>," as recited by claim 1. *Stiles* discloses a system and method "for providing travel information to a consumer," (*Stiles*, abstract) including an "archive center 334 [that] can store all travel information activity" (*Stiles*, col. 14:43-44). *Stiles* discloses that travel information can be used as follows: "if the traveler has a respiratory problem, and the altitude of the destination is sufficiently high, then a warning notice will be retrieved" (*Stiles*, col. 2, lines 6-8). Storing data regarding a traveler's respiratory problems, as taught by *Stiles*, does not constitute a teaching or suggestion of storing metric data "that describes <u>characteristics of a software product</u>," as recited by claim 1.

Further, claim 1 recites a combination including, for example, "retrieving from the metrics database a <u>set of tags</u>" (emphasis added). *Stiles* fails to teach or suggest at least this additional element, nor does the Examiner point to any language in *Stiles* that allegedly teaches or suggests the claimed "set of tags." The Examiner merely copies two pages of *Stiles'* disclosure into the Office Action (Office Action at pp. 3-5).

M.P.E.P. § 706 instructs: "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has an opportunity to ... reply completely." Copying large portions of *Stiles* into the Office Action without any explanation as to how those portions allegedly teach or suggest Applicant's claim language does not clearly articulate the rejection (see Office Action at pp. 3-7). Applicant respectfully requests that any subsequent Office Action be made non-final and clearly articulate how the reference(s) allegedly teach or suggest each and every claim element such that Applicant may be given a fair opportunity to reply.

Indeed, the large portion of *Stiles* that the Examiner copied into the Office Action does not mention a "tag" or a "set of tags," as recited by claim 1. Neither this portion nor any other portion of *Stiles* teaches or suggests "determining a <u>subset of unique tags</u> from the set of tags based on a set of parameters included in the query," as recited by claim 1.

Because *Stiles* fails to teach or suggest each and every element recited by claim 1, *Stiles* cannot anticipate this claim. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 1 and dependent claims 2-10 under 35 U.S.C. § 102(e) as being anticipated by *Stiles*.

With respect to claims 11-39, the Examiner has not addressed any of the elements recited by these claims. The Examiner must clearly articulate how *Stiles* allegedly teaches or suggests each and every element in order to give Applicant a fair opportunity to reply. The Examiner, however, merely quoted Applicant's claim language and asserted: "Claims 11-39 are similarly rejected as in claims 1-10" (Office Action at pp. 9-13). This assertion fails to address each and every element recited by claims 11-39, which contain numerous elements of different scope than claims 1-10.

Independent claims 11 and 12 recite "a metrics database comprising metrics data that describes characteristics of a software product" and "a set of tags," similar to claim 1. Accordingly, for at least the reasons discussed above with respect to claim 1, *Stiles* cannot anticipate independent claims 11 and 12 and dependent claims 13-16.

Moreover, claim 11 recites a combination including:

retrieving from the metrics database a set of tags and a <u>set of additive attributes</u> associated with the set of tags;

combining like additive attributes from the set of additive attributes to produce a
        set of group attributes; and

assigning a group tag to the set of group attributes.

Emphasis added. *Stiles* fails to teach or suggest at least these additional elements, nor

has the Examiner identified any portion of *Stiles* containing such teachings.

Accordingly, for at least this additional reason, *Stiles* cannot anticipate independent

claim 11.

Stiles also does not disclose each and every element of claim 17. Claim 17

recites a combination including, for example:

        a group tag;
        a set of tag identifiers; and
        a command for grouping a set of metrics data wherein, upon
                reading the command, the interface module initiates a grouping
                module for:
                        retrieving a set of tags corresponding to the set
                                of tag identifier;
                        retrieving a set of additive attributes associated
                                with the set of tags;
                        combining like additive attributes from the set
                                of additive attributes to produce a set of group
                                attributes, and
                        assigning the group tag to the set of group
                                attributes

(Emphasis added). The Office Action does not address how *Stiles* allegedly teaches or

suggests "a group tag," "tag identifiers," "set of metrics data," "a grouping module," "a

set of tags," "a set of additive attributes," or "a set of group attributes," as recited by

claim 17. Rather, to reject claim 17, the Office Action merely recites Applicant's claim

language without any reference to *Stiles* (Office Action at p. 10). Because the Office

Action does not adequately address claim 17, Applicant submits that the rejection based

on *Stiles* should be withdrawn.

Further, neither the cited portion of *Stiles*, nor any other portion thereof, teaches or suggests at least "a group tag," "tag identifiers," "set of metrics data," "a grouping module," "a set of tags," "a set of additive attributes," or "a set of group attributes," as recited by claim 17. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 17 under 35 U.S.C. § 102(e) as being anticipated by *Stiles*.

Independent claims 18, 28, 29, and 39, although of different scope, recite elements similar to elements recited by independent claim 17. Claims 19-27 and 30-38 depend from independent claims 18 and 29. Accordingly, claims 18-39 are allowable over *Stiles* at least for the reasons discussed above regarding claim 17.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Should the Examiner continue to dispute the patentability of the claims after consideration of this reply, Applicant encourages the Examiner to contact Applicant's undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.
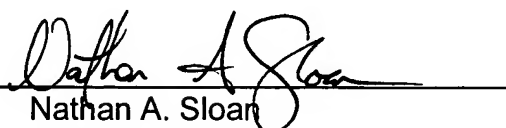
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: June 30, 2006

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